

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

TESSERA, INC.,

Plaintiff,

v.

ADVANCED MICRO DEVICES, INC. et al.,

Defendants.

AND RELATED COUNTERCLAIMS.

No. C 05-4063 CW

ORDER GRANTING
TESSERA'S MOTION FOR
A RULING THAT IT HAS
COMPLIED WITH THE
COURT'S ORDER OF
NOVEMBER 1, 2007

Tessera moves for a ruling that it has complied with the Court's November 1, 2007 preliminary injunction. Defendants STATS ChipPAC Ltd., STATS ChipPAC (BVI) Limited, STATS ChipPAC, Inc., Advanced Semiconductor Engineering, Inc., ASE (U.S.) Inc., ChipMOS Technologies, Inc. and ChipMOS, U.S.A., Inc. oppose Tessera's motion. The matter was submitted on the papers. Having considered all of the papers submitted by the parties, the Court grants Tessera's motion.

The Court's previous orders on various Defendants' motions for preliminary injunctions discuss the facts and legal issues relevant to the present motion. See Docket Nos. 570, 686, 742. The Court's order of November 1, 2007 provided:

Before filing any complaint against the ASP Defendants,

1 Plaintiff must give them notice of its proposed action,
2 accompanied by a copy of the proposed complaint. The
3 notice must identify the accused products and demonstrate
4 that they do not fall within the scope of Plaintiff's
5 license agreements with the ASP Defendants. The ASP
6 Defendants may respond to the notice within ten days. If
7 they take the position that the products are covered by
8 their licenses, Plaintiff may not bring its proposed
9 action. If they do not, Plaintiff will be permitted to
10 proceed with its action.

11 Docket No. 570 at 13-14.

12 Tessera has now provided the moving Defendants with a proposed
13 ITC complaint naming them as respondents. The complaint identifies
14 only laminate-based chip packages as representative of the accused
15 products, whereas the relevant license agreements cover only tape-
16 based packages. The complaint also explicitly refers to the
17 license agreements and the Court's preliminary injunction,
18 representing that Tessera is not pursuing claims based on tape-
19 based products or products otherwise within the licensed field of
20 use. Brown Dec. Ex. B ¶¶ 17-27. In a letter to ChipMOS, Tessera
21 also offered to stipulate that "laminate-based package substrate
22 . . . products are not covered by the license agreement." Id. Ex.
23 I.

24 The moving Defendants have not taken the position that any of
25 the representative accused products in the ITC complaint are
26 covered by their licenses. But they maintain that Tessera will not
27 have complied with the Court's order if it files its ITC complaint
28 without first signing a stipulation agreeing that "laminate-based
package substrate . . . products do not give rise to any cause of
action against any of the ChipMOS defendants or their customers for
breach of contract in connection with the License Agreement" Id.

1 Ex. L.

2 The Court's preliminary injunction does not require Tessera to
3 sign such a stipulation. In order for Tessera to be precluded from
4 pursuing an infringement claim in the ITC, there must be an actual
5 dispute over whether particular sales of the accused products fall
6 within the scope of the license agreement. The forum selection
7 clause simply does not bind the parties vis-a-vis infringement
8 claims based on products or sales that nobody argues are subject to
9 the terms of the license agreement.

10 For these reasons, Tessera's motion (Docket No. 712) is
11 GRANTED. Tessera may proceed with its proposed ITC action against
12 the moving Defendants.

13 IT IS SO ORDERED.

14
15 2/19/08

16 Dated: _____



CLAUDIA WILKEN
United States District Judge